



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,827	09/29/2003	Mathew R. Roth	0342UR	2524

7590 02/28/2007
Paul S. Rooy
2620 S. Peninsula Dr
Daytona Beach, FL 32118

EXAMINER

KOEHLER, CHRISTOPHER M

ART UNIT	PAPER NUMBER
----------	--------------

3726

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/28/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/673,827

Applicant(s)

ROTH ET AL.

Examiner

Christopher M. Koehler

Art Unit

3726

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7,19,21,22 and 26-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 26-29 is/are allowed.
- 6) ☒ Claim(s) 1,3-7,19,21 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/26/2007 has been entered.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1, 3, 4, 19 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Morford (US Patent No. 6,068,894).

Claim 1:

Morford teaches a method of manufacturing a leaf display device made of broadleaf stems, each said broadleaf stem comprising a plurality of leaves comprising a first, topmost leaf, a second leaf adjacent said first leaf, and a third leaf adjacent said second leaf, said method comprising the steps of: A. Positioning said first leaf substantially co-linearly with said broadleaf stem; B. Positioning said second leaf over said first leaf; C. Positioning said third leaf over said second leaf; and D. Continuing this positioning process on each successive leaf progressing along said broadleaf stem away from said first leaf until all leaves desired are stacked (**Col. 4 lines 6-29; Figs. 7B**

Art Unit: 3726

and 8B); and E. Selecting which surface of each leaf should be visible when viewed from a visible side of the stacked broadleaf stem, the visible side of the stacked broadleaf stem being a side of the broadleaf stem upon which the last leaf was stacked. With regards to step E., it is inherent that in the manufacture of a leaf display device made of broadleaf stems the manufacturer must select a visible surface for each of the leaves since each leaf has at least two surfaces. Furthermore, Morford teaches that the leaves used are preserved naturally occurring leaves and that untreated and unpreserved, therefore purely naturally occurring, leaves may also be used in the same process (**col. 3, lines 43-59**).

Claim 3:

Morford also teaches the method of claim 1 wherein a width of said stacked broadleaf stem is substantially equal to twice an average width of the leaves comprising said finished stacked broadleaf stem (**Fig. 7B**).

Claim 4:

Morford also teaches the method of claim 3 as described above, further comprising the step of removing a top portion of a broadleaf stem as necessary to provide a single leaf emerging from a top of the stem. "As necessary" implies that no leaves could be removed. As shown in **Fig. 4**, a single leaf emerges from a top of the stem.

Claim 19:

Morford teaches a method of manufacturing a leaf display device comprising the steps of: A. Positioning a top leaf on a broadleaf stem substantially co-linear with said

Art Unit: 3726

broadleaf stem; B. Positioning a leaf adjacent said top leaf substantially parallel to, and partially on top of said top leaf; C. Positioning a leaf adjacent the leaves already stacked substantially parallel to, and partially on top of the previously stacked leaves; and D. Repeating the previous step until all leaves desired to be stacked have been stacked **(Col. 4 lines 6-29; Figs. 7B and 8B)**; and E. Selecting which surface of each leaf should be visible when viewed from a visible side of the stacked broadleaf stem, the visible side of the stacked broadleaf stem being a side of the broadleaf stem upon which the last leaf was stacked. With regards to step E., it is inherent that in the manufacture of a leaf display device made of broadleaf stems the manufacturer must select a visible surface for each of the leaves since each leaf has at least two surfaces.. Furthermore, Morford teaches that the leaves used are preserved naturally occurring leaves and that untreated and unpreserved, therefore purely naturally occurring, leaves may also be used in the same process **(col. 3, lines 43-59)**.

Claim 21:

Morford also teaches the method of claim 19 wherein a width of said stacked broadleaf stem is substantially equal to twice an average width of the leaves comprising said finished stacked broadleaf stem **(Fig. 7B)**.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. In the event that applicant traverses the inherency applied to claims 1 and 19 above, claims 1 and 19 are further rejected under 35 U.S.C. 103(a) as being

unpatentable over Morford (U.S. Patent No. 6,068,894) in view of Higdon et. al. (U.S. Patent No. 4,011,677).

Morford teaches the methods of claims 1 and 19 as described above but does not explicitly state the method comprising the further step of selecting which surface of each said leaf should be visible when viewed from a visible side of the stacked broadleaf stem, said visible side of said stacked broadleaf stem being a side of said broadleaf stem upon which said last leaf was stacked.

Higdon teaches the method of selecting which surface of each said leaf should be visible when viewed from a visible side of the stacked broadleaf stem, said visible side of said stacked broadleaf stem being a side of said broadleaf stem upon which said last leaf was stacked **(Col. 3 lines 45-55)** for the purpose of accomplishing a desirable appearance.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated the appearance selection method of Higdon with the method of Morford for the purpose of accomplishing a desirable appearance in a leaf display device.

6. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being obvious over Morford.

7. Morford teaches the invention cited with the exception of trimming lower portion leaves and trimming the stem. However, it was well known to a person of ordinary skill in the art at the time of invention to trim a lower leaf and stem portion in order to remove dead leaves and in order to shorten the length of the stem. Since applicant failed to

Art Unit: 3726

traverse the examiner's taking of official notice in the first office action, applicant is considered to have concurred with the examiner that this trimming step was well known in the art prior to applicant's invention. Thus, it would have been obvious to one of ordinary skill in the art to have performed the claimed trimming step for aesthetic purposes.

8. Claim 7 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morford (U.S. Patent No. 6,068,894) in view of Li (U.S. Patent No. 5,759,645).

9. Morford teaches the methods of claims 1 and 19 as described above but fails to specifically teach the method comprising the further step of attaching one or more of said stacked broadleaf stems to a leaf display device frame.

10. Li teaches the method of attaching one or more stacked broadleaf stems **70** to a leaf display device frame **94** for the purpose of displaying leaves (**Col. 1 lines 14-53**).

11. It would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated the display device frame for the purpose of displaying one or more broadleaf stems.

Allowable Subject Matter

12. Claims 26-29 are allowed.

Response to Arguments

13. Applicant's arguments filed 12/13/2006 have been fully considered but they are not persuasive. The arguments filed rely on the declaration addressed below.

Art Unit: 3726

14. The declaration under 37 CFR 1.132 filed 12/13/2006 is insufficient to overcome the rejection of claims 1, 3-7, 19 and 21-22 based upon anticipation of the Morford reference as set forth in the last Office action because:

15. The applicant has failed to provide a nexus between the claimed subject matter and its commercial success. Applicant has attributed the commercial success of the method of the application to the aesthetics of the design. However, the claimed steps of the method, specifically step E., merely requires selecting the visible side of a leaf and not that the visible side is aesthetically pleasing by itself or when stacked with other leaves. By the claimed method the manufacturer could chose the least aesthetically pleasing side of every leaf and still satisfy the requirements of the claim, however it would stand to reason that this stacking of leaves would not achieve commercial success.

16. In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Koehler whose telephone number is (571) 272-3560. The examiner can normally be reached on Mon.-Fri. 7:30A-4:00P.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bryant can be reached on (571) 272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3726

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CMK



DAVID P. BRYANT
SUPERVISORY PATENT EXAMINER

2/17/07